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| 10/809,347      | 03/26/2004  | Satoshi Saito        | Q80240              | 7548             |

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WASHINGTON, DC 20037-3213

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| EXAMINER |
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DOVE, TRACY MAE

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| ART UNIT | PAPER NUMBER |
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1745

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10/04/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/809,347

Applicant(s)

SAITO ET AL.

Examiner

Tracy Dove

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 11, 12, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 11, 12, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/863,458.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

This Office Action is in response to the communication filed on 8/29/07. Applicant's arguments of 8/3/07 have been considered, but are not persuasive. Claims 1, 11, 12, 21 and 22 are pending.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/29/07 has been entered.

***Drawings***

The deletion of Figure 15 is required in this application because the new drawing sheet containing Figure 15 submitted 8/3/07 contains new matter. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Specification***

The amendment filed 8/3/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the description of new Figure 15 on page 17, line 2; and on page 19, lines 5-11. As stated above, Figure 15 contains new matter. The specification as filed does

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not support ribs formed on the outside surface of the cover are positioned corresponding to the electrodes. The ribs are disposed symmetrically with the annular projections.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Priority***

Applicant cannot rely upon the foreign priority papers to overcome this rejection because the translation of said papers does not support the entire claimed invention. See new matter rejections below regarding claim 1, 21 and 22. Note if these claims are canceled or amended as suggested by the Examiner below, it appears claims 11 and 12 are allowable over the prior art of record because Marukawa (US6,275,003) would no longer be available as prior art against the claimed invention.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1, 11, 12, 21 and 22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,773,850. Although the conflicting claims are not identical, they are not patentably distinct from each other because both require a shock-absorbing structure of a battery cover comprising a battery cover which protects at least one battery and a plurality of shock-absorbing ribs formed on an outer surface of the battery cover.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites "the plurality of shock-absorbing ribs are formed so as to be disposed at positions respectively corresponding to positions of a plurality of electrodes", which is not supported by the specification as filed. The specification discloses annular projections formed on the inside surface of the cover that surround the electrode terminals and ribs formed on the outside surface of the cover. The annular projections and the ribs are disposed substantially symmetrically with respect to the plane of the cover (page 22). The specification does not appear to disclose ribs formed on the outside surface of the cover are positioned

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corresponding to the electrodes. The ribs are disposed symmetrically with the annular projections.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites “disposed at positions respectively corresponding to positions of a plurality of electrodes”, which is indefinite. It is unclear what “positions respectively corresponding to positions” encompasses.

To the extent the claims are understood in view of the 35 U.S.C. 112 rejections above, note the following prior art rejections.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 11, 12, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Marukawa et al., US 6,275,003.

Marukawa teaches a battery having a cover 25,26 made of synthetic resin. A portion on the inside surface of the cover facing the connecting terminal 5,6 is provided with annular ribs 27. The annular ribs surround the periphery of portions of the connecting terminal that projects beyond nut 24 (fixing member). Furthermore, reinforcing ribs 28 are formed in a lattice fashion on at least a portion of the outer surface of the cover facing the connecting terminal and on the periphery of the cover (5:42-62). Figure 5A shows the annular rib 27 extends towards and abuts against the nut 24 such that a bottom surface of the annular rib 27 opposes an upper surface of the nut. Figure 5A also show the terminal is received in the annular rib 27 and the reinforcing ribs 28 extend perpendicular to the outer surface of the cover. Thus the claims are anticipated.

Note the specification teaches ribs formed in a lattice pattern on the outer surface of the cover are “disposed at positions respectively corresponding to positions of a plurality of electrodes of the at least one battery”. See also Figure 5A.

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Claim 1, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Henk, US 4,400,449.

Henk teaches a battery having a top cover 43 with ribs 53 on the upper side of the cover. See Fig. 5 and col. 9, lines 11-14. The cover may comprise polystyrene (note the claims do not require the cover to *consist* of an insulating synthetic resin). Figure 5 is a top view of the battery of Figure 3 (7:7-8). The battery has electrodes. Thus the claims are anticipated.

### ***Response to Arguments***

Applicant's arguments filed 8/3/07 have been fully considered but they are not persuasive. Applicant asserts the specification discloses that ribs 2 are formed so as to be

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disposed at positions corresponding to the electrodes of the battery. Applicant states this is supported at page 19, lines 5-11 of the specification. However, the ribs do not appear to correspond to the electrodes of the battery, but correspond to the externally-threaded electrodes of the battery. If the claims were amended to recite "externally-threaded electrodes of the battery", the new matter rejection will be withdrawn. Furthermore, the claims have been rejected as indefinite because "positions respectively corresponding to positions" has not been clarified.

Regarding Henk, the rejection is made to the extent the claims are understood in view of the indefinite rejection. Applicant has not defined "corresponding to".

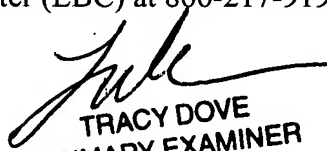
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is 571-272-1285. The examiner can normally be reached on Monday-Thursday (9:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 29, 2007



TRACY DOVE  
PRIMARY EXAMINER